

**REMARKS**

**I. Introduction**

Claims 1-25 and 38-40 are pending in this application. Claims 32-37 were withdrawn by the Examiner following a Restriction Requirement. Claims 8-12 and 18 were rejected under 35 U.S.C. § 112, second paragraph; claims 1, 2, 7, 13, 14, 17, 18 and 22-27 were rejected under 35 U.S.C. § 102(b); claims 3-6 and 28-31 were rejected under 35 U.S.C. § 103(a) and claims 14, 15 and 19-21 were objected to as being dependent upon a rejected base claim, but would be allowable if rewritten in independent form. The Examiner also noted that claims 8-12 would be allowable if rewritten to overcome the rejections under § 112, second paragraph and to include all of the limitations of the base claim and any intervening claims.

Claims 1, 8, 12-18 and 25 have been amended to include proper antecedent basis for all of the claim elements. Claims 26-37 have been cancelled without prejudice. New claims 38-40 have been added. Claim 38 is supported by, and is a combination of original claims 1, 7 and 8; claim 39 is supported by, and is a combination of original claims 1, 7, 13 and 14; and claim 40 is supported by, and is a combination of original claims 1 and 19.

No new matter has been added.

For the following reasons the application should be allowed, and the case passed to issue.

**II. Claim Rejections under 35 U.S.C. § 112, second paragraph**

Claims 8-12 and 18 were rejected under 35 U.S.C. § 112, second paragraph as allegedly being indefinite for failing to point out and distinctly claims the subject matter regarded as the invention. Applicants respectfully submit that the amendments made to the claims obviate the rejection and all the claims satisfy the requirements of 35 U.S.C. § 112.

**III. Rejections under 35 U.S.C. § 102(b)**

Claims 1, 2, 7, 13, 14, 17, 18 and 22-27 were rejected under 35 U.S.C. § 102(b) as allegedly being anticipated by Groesbeck U.S. 5,810,185. Applicants respectfully disagree.

The subject matter of claim 1 a closure suitable for mounting onto a container and comprising a top cap and a top cap sealing member. Claim 1 recites, in pertinent part,

“the top cap sealing member forms a seal with the outer surface of the spout and at least a second position where the plug member is withdrawn from the opening; and

wherein on relative movement of the top cap from said first position towards said second position, the top cap sealing member rides up over said at least one protuberance so as to at least partially release the seal made by the top cap sealing member with said spout.”

Anticipation under 35 U.S.C. § 102 requires that “each and every element as set forth in the claim is found, either expressly or inherently described, in a single prior art reference.”

*Verdegaal Bros. v. Union Oil Co. of California*, 814 F.2d 628, 631, 2 USPQ 2d 1051, 1053 (Fed Cir. 1987). At a minimum, the cited prior art does not disclose (expressly or inherently) a top cap sealing member" which firstly seals with the outer surface of the spout and rides up and over a protuberance on movement of the top cap relative to the spout.

The Examiner points to features 18 and 19 in Groesbeck for allegedly disclosing a protuberance 18 and a sealing member 19 that rides over 18, wherein the closure has a first position shown in figure 3. See Office Action dated April 29, 2008 at pages 3 and 4.

However, it is clear from column 3, lines 59-62 of Groesbeck, that these features are merely "annular snap-acting retainers," not a protuberance and/or sealing member configured as recited in claim 1.

In fact, elements 18 and 19 of Groesbeck (see FIG. 3), play no role in sealing the top cap to the spout which is instead performed by the sealing ring (12)

Moreover, the purpose of the recited top cap sealing member and the protuberances in the present application is clearly described in the specification at page 19, lines 25-27, such that the downward release of pressure is provided when the top cap is firstly moved upwardly relative to the spout.

Therefore, Groesbeck fails to disclose all of the elements of claim 1.

Accordingly claim 1 is allowable over the cited prior art reference.

Furthermore claims 2-25 depend from and further define the subject matter of claim 1 and therefore are also allowable.

#### **IV. Rejections under 35 U.S.C. § 103(a)**

Claims 3-6 and 28-31 were rejected under 35 U.S.C. § 103(a) as allegedly being unpatentable over Groesbeck in view of Beck U.S. 6,024,256. Applicant respectfully traverse the rejection.

In order to establish a *prima facie* obviousness rejection under 35 U.S.C. § 103(a), basic criteria must be met. First, there must be some suggestion or motivation, either in the references themselves or in the knowledge generally available to one of ordinary skill in the art, to modify the reference or to combine reference teachings. Second, there must be a reasonable expectation of success. The teaching or suggestion to make the claimed combination and the reasonable expectation of success must not be based on applicant's disclosure. *In re Vaeck*, 947 F.2d 488, 20 USPQ2d 1438 (Fed. Cir. 1991).

Further, "rejections on obviousness grounds cannot be sustained by mere conclusory statements; instead, there must be some articulated reasoning with some rational underpinning to support the legal conclusion of obviousness." *In re Kahn*, 441 F. 3d 977, 988 (Fed. Cir. 2006).

the legal conclusion of obviousness.” *In re Kahn*, 441 F. 3d 977, 988 (Fed. Cir. 2006). At a minimum, neither Groesbeck or Beck teach or suggest a top cap sealing member which firstly seals with the outer surface of the spout and rides up and over a protuberance on movement of the top cap relative to the spout.

As discussed above, in reference to the rejection under 35 U.S.C. § 102(b), at a minimum Groesbeck fails to disclose, a top cap sealing member which firstly seals with the outer surface of the spout and rides up and over a protuberance on movement of the top cap relative to the spout.

Moreover, Beck fails to ameliorate the deficiencies of Groesebeck as Beck also fails to teach or suggest the subject matter of claim 1, which recites in pertinent part, that,

“the top cap sealing member forms a seal with the outer surface of the spout and at least a second position where the plug member is withdrawn from the opening; and wherein on relative movement of the top cap from said first position towards said second position, the top cap sealing member rides up over said at least one protuberance so as to at least partially release the seal made by the top cap sealing member with said spout.”

Indeed, the Examiner concedes that Groesbeck does not disclose a plurality of protuberances on the spout as claimed, and therefore relies on Beck for this alleged disclosure and refers to elements 22 of Beck as being such protuberances.

However, Beck too is deficient in disclosing such a plurality of protuberances on the spout in a configuration as claimed. This is because, “frangible spot seals or connections 22,” (see Beck col. 3, lines 41-44), are not protuberances, “wherein on relative movement of the top cap from said first position towards said second position, *the top cap sealing member rides up over said at least one protuberance so as to at least partially release the seal made by the top cap sealing member with said spout,*” as recited in claim 1.

Rather, elements 22 of Beck are actually frangible bridges connecting the skirt to a "top cap" to a tamper evident band (or skirt 24), and do not allow a top cap sealing member to ride up and over them so as to at least partially release a seal made by a top cap sealing member with a spout.

As such, neither Groesbeck nor Beck, either alone or in combination teach or suggest all of the elements of claim 1.

Accordingly, claim 1 is allowable over the cited prior art references.

Furthermore, claims 2-25 depend from and further define the subject matter of claim 1 and therefore are also allowable.

**V. New claims 38-40**

As noted by the Examiner on page 4, that claims 14, 15 and 19-21 would be allowable if rewritten in independent form. The Examiner also noted that claims 8-12 would be allowable if rewritten to overcome the rejections under § 112, second paragraph and to include all of the limitations of the base claim and any intervening claims.

Claim 38 is supported by and is a combination of original claims 1, 7 and 8; claim 39 is supported by is a combination of original claims 1, 7, 13 and 14; and claim 40 is supported by and is a combination of original claims 1 and 19.

Therefore, claims 38, 39 and 40 include all of the elements of claims 8, 14 and 19 respectively and therefore are allowable.

**VI. Conclusion**

In view of the above amendments and remarks, Applicants respectfully submit that this application should be allowed and the case passed to issue. If there are any questions regarding this Amendment or the application in general, a telephone call to the undersigned would be appreciated to expedite the prosecution of the application.

To the extent necessary, a petition for an extension of time under 37 C.F.R. 1.136 is hereby made. Please charge any shortage in fees due in connection with the filing of this paper, including extension of time fees, to Deposit Account 500417 and please credit any excess fees to such deposit account.

Respectfully submitted,

McDERMOTT WILL & EMERY LLP



Aamer S. Ahmed  
Registration No. 58,958

600 13<sup>th</sup> Street, N.W.  
Washington, DC 20005-3096  
Phone: 202.756.8000 ASA:ajb  
Facsimile: 202.756.8087  
**Date: July 24, 2008**

**Please recognize our Customer No. 20277  
as our correspondence address.**